REMARKS

Claims 16 and 17 have been canceled.

Claim 1 has been amended to claim the full scope of the present invention, namely a nucleic acid that encodes the polypeptide of SEQ ID NO:5.

Claims 3 and 5 have been amended to be depend on claim 1 and to be consistent with amended claim 1.

Claim 11 has been amended to depend from claim 1.

Claim 19 has been amended to clarify that the cell is a plant cell and to depend on claim 5.

New claim 25 has been added to depend from claim 5 and set forth the nucleic acid by sequence indentifier. The nucleic acids set forth in this claim are supported by original claims 1 and 3.

New claims 26-30 have been added to claim vectors containing the various nucleic acids set forth in the original claims.

New claims 31-34 have been added to claim subject matter of original claims 19-21 and a transgenic plant as disclosed in the specification.

It is submitted that these amendments do not constitute new matter and their entry is requested.

In response to the restriction requirement set forth in the outstanding Office Action, Applicants provisionally elect Group I, claims 1, 3, 5, 11-13 and 25-29. This election is made with traverse. In addition, Applicants provisionally elect a nucleic acid sequence which encodes the polypeptide of SEQ ID NO:5 as a species for examination. Claims 1, 3, 5, 11-13 and 25-29 read on the elected species. This election of species is also made with traverse. If a further election of a nucleic acid sequence encoding this polypeptide is deemed necessary, Applicants provisionally elect the nucleotide sequence of SEQ ID NO:3 for examination. This election of species is also made with traverse. Claims 1, 3, 5, 11-13 and 25-29 read on the elected species. This election of species is also made with traverse.

First, Applicants note that the present application is a national stage filing of a PCT application and as such are entitled to claims directed to a product and process in the same application. In addition, Applicants submit that the special technical feature of the present invention is a nucleic acid that encodes a polypeptide having the amino acid sequence of SEQ ID NO:5 and nucleic acids that hybridize under stringent conditions to this nucleic acid and that confers resistance to *Xanthomonas*. This special technical feature is not anticipated by Zhang et al. as is evident by the fact that the Examiner did not include a comparison of the nucleic acids of the present invention and Zhang et al. with the Office Action. Since the present invention defines a contribution over the art, it does contain a special technical feature as defined by PCT Rule 13.2, and thus, all of the claims should be examined together in accordance with the PCT rules

Second, Applicants submit that the an election of nucleic acid species encoding the polypeptide of SEQ ID NO:5 does not constitute an undue burden on the Examiner such that they should not be considered in the same claims. Applicants note that there are two criteria for a proper requirement for restriction between patentably distinct inventions: 1) The inventions must be independent or distinct as claimed; and 2) There must be a serious burden on the Examiner if restriction is not required. See MPEP § 803. Examiners must provide reasons and/or examples to support conclusions. For purposes of the initial requirement, a serious burden on the Examiner may be *prima facie* shown if the Examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria are set forth in MPEP § 803.02. See MPEP § 803. If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the Examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. In such a case, the Examiner will not require restriction. See MPEP § 803.02.

Even if the Examiner could establish any one of the above factors and thus the proposed inventions may be distinct, Applicants submit that restriction is improper because distinctness alone is not enough to require a restriction. There must also be a serious burden upon the Examiner. In the absence of such a burden, the examiner must examine all of the species. It is urged that the burden of examining each of the features of the claims of the present application is not a serious one, and that the burden of examining all of the species, at most, is only slightly greater than examining one of the species. It is submitted that the Examiner cannot show that there is an undue burden in searching each of the species of the nucleic acids that encode the polypeptide of SEQ ID NO:5, i.e., SEQ ID NOs:1, 2, 3 and 4. In fact, Applicants submit that a single search is likely all that is required in order to search all of these species, because as noted in the specification, SEQ ID NOs:3 and 4 code for the polypeptide of SEQ ID NO:5 and the corresponding genomic sequences thus also contain a coding sequence for the polypeptide of SEQ ID NO:5. Furthermore, the consideration of whether the claims comply with the various provisions of the patent statute is the same for each species.

For example, the examination entails various aspects. First is a decision concerning utility under 35 U.S.C. §101. Although each species being claimed may be distinct, they are all related in their utility, namely encoding a polypeptide of SEQ ID NO:5. Consequently, a decision concerning utility will be identical for all of the species, and there is no added burden of examining all of the species as compared to examining only a single species.

The second aspect of examination is whether the provisions of the various paragraphs of 35 U.S.C. § 112 have been met. In general, and in this case, this means reviewing the application and claims for compliance with the provisions of paragraphs 1 and 2 of § 112. As for the enablement aspect as found in paragraph 1 of § 112, all of the species are related to a nucleic acid encoding a polypeptide of SEQ ID NO:5. Since no basis for distinguishing between the enablement of one species vs. another species has been set forth, it is presumed that all of the listed species will be treated equally. Again, this means that only a single decision needs to be made concerning all of the

species. Therefore, this aspect of the examination will not be a serious burden if all species are examined, vs. only one of the species.

Concerning paragraph 2 of § 112, this involves the wording of the claims. The wording of the claims in each group of claims is identical except for the specified species. Consequently, any objections to the language of the claims for one Group of claims will likely be equally applicable to the other Groups of claims. Therefore there is no increase in the burden concerning 35 U.S.C. § 112, second paragraph, if all species are examined.

The third aspect of examination is a review of prior art to determine whether the claims are anticipated or obvious. There are two aspects of such a search. A first aspect is a review of the prior art literature and patents. The literature to be reviewed will be identical for all of the species. All of the claimed species have the same utility. The Examiner has not stated that a search of the scientific literature will be any different for one species than for any other species. Consequently, the search of the patent literature will clearly be the same for all of the species,. Furthermore, Applicants submit that a search for a nucleic acid of SEQ ID NO:3 will identify both a nucleic acid of SEQ ID NOs:1, 2 and 4 as well. Because the search of the scientific literature and patent literature will be identical for all of the species, there is no added burden concerning this aspect if all of the species are examined.

Consequently, it is submitted that the only reason for restriction is that the species may be distinct from each other. But as explicitly stated in MPEP § 803, the inventions must be distinct and there must be a serious burden on the Examiner. MPEP § 803.02 states that if a search and examination of an entire claim can be made without serious burden, the Examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. As urged above, it is asserted that examination of all of the species will not impose a serious burden.

In view of the above remarks, the Examiner is requested to reconsider the restriction requirement as set forth in the Office Action mailed 10 October 2006 and to examine both groups of claims together, as well as examining all of the species in a single action.

Respectfully submitted,

ROTHWELL, FIGG, ERNST & MANBECK, p.c.

By _____

Jeffrey L. Ihnen
Registration No. 28,957
Attorney for Applicant
1425 K Street, N.W., Suite 800
Washington, D.C. 20005
phone: 202-783-6040
fax: 202-783-6031

#1362997v1<RFDMS> -2577-160.Amendment 1